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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,954	02/13/2002	Charles Andrianjara	A0000476-01-CFP	9823

28880 7590 06/10/2004

WARNER-LAMBERT COMPANY  
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EXAMINER
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TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/075,954	<b>Applicant(s)</b> ANDRIANJARA ET AL.	
	<b>Examiner</b> Tamthom N. Truong	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/16/04 (Election)
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16,28,29,32-34 and 37-39 is/are pending in the application.  
     4a) Of the above claim(s) 17-27,30,31,35 and 36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16,28,29,37 and 38 is/are allowed.
- 6) ☒ Claim(s) 32-34 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/6/03 ; 5/28/02 ; 10/31/03</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

It is acknowledged that applicant has elected without traverse Group 3 (the subject matter of formula I wherein  $X_2$  is nitrogen while  $X_1$  and  $X_3$ , each represents  $CR_6$ ) in the response of 04-16-04.

It is noted that claim 19 is drawn to the process of making formula (I) wherein  $X_1$ ,  $X_2$ , and  $X_3$  are CH, which is the non-elected group whereas claim 28 is drawn to the process of making formula (I) wherein  $X_2$  is nitrogen. Therefore, the elected Group 3 is now revised to include claim 28, and not claim 19.

Thus, pending claims are 1-16, 28, 29, 32-34, and 37-39.

Claims 17-27, 30, 31, 35, and 36 are withdrawn from consideration as being drawn to the non-elected subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 32-34 provide for the use of a compound according to any one of claims 1-16, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 32-34 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a

process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Objections***

2. Claim 39 is objected to because it depends on claim 40, which does not exist.

Appropriate correction is required.

### ***References cited on PTO-892***

3. References cited on PTO-892 only show state of the art. Although they disclose the core of pyrido-pyrimidine, they fail to teach the side chain that is equivalent to  $-C(=Y)-Z-(Z_1)_n-A-(R_2)_m$ . Thus, they do not anticipate or render obvious the compounds as elected and claimed herein.

### ***Allowable Subject Matter***

4. Claims are 1-16, 28, 29, and 37-38 are allowable except for the non-elected subject matter, and the presence of non-elected claims 17-27, 30, 31, 35, and 36. Applicant is advised to cancel non-elected claims as well as non-elected subject matter in response to this office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

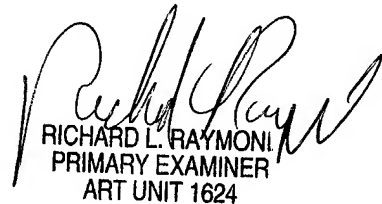
The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



T. Truong

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June 8, 2004



RICHARD L. RAYMONI  
PRIMARY EXAMINER  
ART UNIT 1624